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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/076,313 | 02/19/2002 | Robert J. Johnston | 56134-5001 | 1988 |

7590 03/04/2004

Morgan, Lewis & Bockius LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004

EXAMINER

PARSLEY, DAVID J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3643

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/076,313 | | JOHNSTON, ROBERT J. | |
| | Examiner | | Art Unit | |
| | David J Parsley | | 3643 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-19-02 and 8-2-02</u> . | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

Preliminary Amendment

1. Entry of applicant's preliminary amendment dated 2-19-02 into the application file is acknowledged.

Priority

2. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a divisional of Application No. 09/605,718, filed 6-27-2000." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims depend from a canceled claim and therefore it is unclear to what the limitations of the claimed invention are to be.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,391,078 in view of U.S. Patent No. 4,297,810 to Hansford or U.S. Patent No. 5,917,112 to Van Stephoudt.

The above identified claim of applicant's patent U.S. 6,391,078 sets forth all of the method limitations/steps as claimed except using the process to reclaim coal strip-mining or deep-mining soil. The Hansford and Van Stephoudt references disclose adding a composition to strip-mined soil to reclaim the soil – see for example the abstract of Hansford and column 2 lines 16-27 of Van Stephoudt. Therefore it would have been obvious to one of ordinary skill in the art to take the method of growing plants/ improving plant yield using the claimed composition of applicant's U.S. 6,391,078 and use this method for reclaiming strip-mining soil as seen in Hansford or Van Stephoudt, so as to reduce soil erosion and to remediate contaminated soil.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to soil conditioning methods in general:

U.S. Pat. No. 3,770,411 to Chambers – shows plant growth composition

U.S. Pat. No. 3,888,418 to Seith et al. – shows reclaiming mined soil

U.S. Pat. No. 4,067,716 to Sterrett – shows plant growth composition

U.S. Pat. No. 4,235,562 to Ribas – shows reclaiming mined soil

U.S. Pat. No. 4,928,427 to Patterson – shows reclaiming mined soil

U.S. Pat. No. 4,985,060 to Higa – shows plant growth composition

U.S. Pat. No. 5,013,349 to Tanaka – shows plant growth composition

U.S. Pat. No. 5,302,524 to Van De Venter – shows plant growth composition

U.S. Pat. No. 5,409,508 to Erickson – shows reclaiming mined soil

U.S. Pat. No. 5,608,989 to Behrens – shows plant growth composition

U.S. Pat. No. 6,458,179 to Puskarich – shows plant growth composition

DE Pat. No. 19514333 – shows reclaiming mined soil

JP Pat. No. 7-26260 – shows plant growth composition

JP Pat. No. 6-145663 – shows plant growth composition

GB Pat. No. 2234746 – shows plant growth composition

Art Unit: 3643

6. Any inquiry concerning this communication from the examiner should be directed to David Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on Monday-Friday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574.



Peter M. Poon
Supervisory Patent Examiner
Technology Center 3600

3/2/04